

## **REMARKS**

Applicant has carefully studied the outstanding Office Action. The present Response is intended to be fully responsive to all points of rejection raised by the Examiner and is believed to place the application in condition for allowance. Favorable reconsideration and allowance of this application are respectfully requested. No new matter has been added by any of the amendments to the specification. Applicant respectfully requests reconsideration and withdrawal of the Examiner's rejections in view of the foregoing amendments and following remarks.

### **CLAIM REJECTIONS – 35 U.S.C. § 112**

#### **Claims 3-4 & 11**

This rejection is respectfully traversed. The Examiner has rejected claims 3-4 and 11 under 35 U.S.C. § 112 as being "indefinite" and failing to particularly point out and distinctly claim the subject matter.

The Examiner stated that "In claim 3, the phrase 'wherein each said hole' is unclear since the dependent subject matter [claim 2] previously recites 'at least one hole.'" In response, Claim 3 is currently amended to include Examiner's suggestion and is thus clear as to what is claimed. Claim 4 depends from currently amended claim 3 and no longer depends from an indefinite claim.

The Examiner stated that Claim 11 does not have a proper antecedent basis. Claim 11 has been currently amended to reflect that it is dependent on claim 10 and now has a proper antecedent basis.

### **CLAIM REJECTIONS – 35 U.S.C. § 102**

#### **Claims 1, 10-12, and 14**

This rejection is respectfully traversed. The Examiner has rejected claims 1, 10-12, and 14 under 35 U.S.C. § 102(b) as being "anticipated" by Marquette (U.S. Patent No. 3,891,288).

In particular, the Examiner stated:

"Marquette (figures 1-11f) teaches of a storage system comprising: a drawer (10) having a top surface; a frame (38) for accepting at least one drawer; and a top plate (150) for removably placing over the top surface of the drawer, wherein the top plate covers all the top surface of the drawer, wherein the drawer has a bottom plate (28) capable of supporting articles."

Such rejection under §102 for anticipation requires that the single reference teach each and every element or step of the rejected claim. *See, Atlas Powder v. E.I. DuPont*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984). A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Examiner's rejection under §102 fails to meet this test.

Claims 1, 10-12, and 14, as currently amended, include a novel element not taught or suggested by Marquette '288. Nowhere does Marquette '288 teach or suggest combining a top plate with a drawer wherein the top plate has at least one hole for a sample tube. Therefore, Marquette '288 does not anticipate claims 1, 10-12, and 14 as currently amended, and thus a rejection under 35 U.S.C. § 102 is improper. Applicant respectfully requests Examiner to withdraw this rejection.

#### **Claims 1-3, 10, 12, and 14**

This rejection is respectfully traversed. The Examiner has rejected claims 1-3, 10, 12, and 14 under 35 U.S.C. § 102(b) as being "anticipated" by Japanese publication 2001-238744 ("JP '744"). In particular, the Examiner stated:

"JP '744 (figures 1-5) teaches of [sic] a storage system comprising: a drawer (10) having a top surface; an inherent frame for accepting the drawer; and a top plate (35) for removably placing over the top surface of the drawer, wherein the top plate has at least one hole (38) capable of receiving an article, wherein the at least one hole has a removable insert (40), wherein the drawer has a face plate (14), wherein the top plate covers some of the top surface of the drawer, wherein the drawer has a bottom plate (12) capable of supporting articles."

Such rejection under §102 for anticipation requires that the single reference teach each and every element or step of the rejected claim. *See, Atlas Powder v. E.I. DuPont*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984). A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Examiner's rejection under §102 fails to meet this test.

The English translation of the Japanese abstract of JP '744 reads as follows:

PROBLEM TO BE SOLVED: To provide an aromatic structure for drawer in which an aromatic is arranged in a drawer, and the aromatic effect of the aromatic can be continued over a long period. SOLUTION: The drawer 10 opened in its upper part comprises the aromatic 18 arranged on the inner surface side of a bottom plate 12 and a tray 19 for covering the aroma. The tray 19 has a raised bottom 20 capable of forming a closed space S with the bottom plate 12, and the raised bottom part 20 has a hole 29 for releasing the aromatic component of the aromatic 18. A release sheet 30 blocking the hole 29 provided in such a manner as to be capable of closing the hole 29 to regulate the release is stuck to the raised bottom part 20.

70 With reference to the figures JP '744 and to the abstract, contrary to what the Examiner has stated, element 12 is a bottom surface, not a "top surface." Furthermore, the "top plate" or insert is to create a new bottom surface of the drawer. The shape of the "top plate" (as shown in Figures 4-5 of JP '744) is such that it creates a reservoir or depression. Thus, JP '744 teaches a "top plate" which is really the bottom of a drawer. In contrast, as shown in Figures 2, and 6-7 of  
75 the proposed invention, the holes are in a "top plate" which is actually the top of the drawer. Tops of objects, such as sample tubes, may protrude out the top, but the bottom of the drawer is formed by other elements than the ones having holes. Further, JP '744 teaches that any items placed in the drawer, such as a sample tube, would not be placed in the hole. In this regard, JP '744 is teaching away from the proposed invention. JP '744 teaches creating a hole of such  
80 capacity to allow aromatics to escape, not for the insertion and support of some other solid object.

In conclusion, claims 1, 10-12, and 14, as currently amended, include a novel element not taught or suggested by JP '744. Nowhere does JP '744 teach or suggest the claim limitation found in claim 1 stating the combination of a top plate with a drawer wherein the top plate has at  
85 least one hole to accept, support and organize sample tubes. Therefore, JP '288 does not fully anticipate claims 1, 10-12, and 14 as currently amended, and thus a rejection under 35 U.S.C. § 102 is improper. Applicant respectfully requests Examiner to withdraw this rejection.

#### **CLAIM REJECTIONS – 35 U.S.C. §103(a)**

##### **Claims 1-4, 10, 12 and 14**

90 The Examiner rejected claims 1-4, 10, 12 and 14 under 35 U.S.C. §103(a), as being unpatentable over Wang (U.S. Patent No. 4,895,650) in view of Marquette (U.S. Patent No. 3,891,288). The Examiner has stated that:

95 "Wang (figures 1-4a) teaches of [sic] a storage system comprising: a drawer . . . having a top surface; and a top plate (51) for removably placing over the top surface of the drawer, wherein the at least one hole has a removable insert (152a), wherein the removable insert has a through-hole for stabilizing an article (note fig. 1), wherein the drawer has a face plate (22), wherein the top plate covers all of the top surface of the drawer, wherein the drawer has a bottom plate (21) capable of supporting articles. Wang teaches applicant's inventive claimed structure as disclosed above, but  
100 does not show a frame for accepting the drawer. Marquette is cited as an evidence reference to show that it was known in the art to house a storage structure (10) within a frame (38)."

This rejection is respectfully traversed. Independent claim 1 is non-obviousness despite the teachings of Wang '650 in view of Marquette '288. The prior art cited by Examiner does not, either alone or in combination, teach or disclose every element of Applicant's invention in Claims 1-4, 10, 12 and 14; claims 3-4, 10, 12 and 14 depend from independent claim 1, and thus contain the limitations of claim 1. Claim 2 is cancelled.

First, Examiner's language is unclear in regard to Wang '650. In Paragraph 11, Examiner uses element 21 of Wang '650 as both a "top surface" ("can be viewed as the top surface of element 21 for example – fig. 2") and a "bottom plate" ("the drawer has a bottom plate (21)") in rejecting claims 1-4, 10, 12 and 14. It would be more reasonable to call element 51 in fig. 2 a "top surface" and element 21 a "bottom plate." Wang '650 teaches a separable top tray (element 50) and a separable bottom tray (element 20) as part of a test tube rack for magnetically separating components of a mixture. Wang '650 does not teach the element of a drawer.

Second, it is well established that as a part of Examiner's burden to establish a *prima facie* case of obviousness, Examiner is required to show that the referenced teachings "appear to have suggested the claimed subject matter." *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143, 147 (C.C.P.A. 1976). As stated by the Federal Circuit, "Obviousness cannot be established by combining teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination." *In re Geiger*, 815 F.2d 683, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987).

Contrary to Examiner's observation, Wang '288 does not teach a system with a drawer, nor the combination of a test tube rack and a drawer. Neither Wang '650 nor Marquette '288, either alone or in combination, teach or disclose every element of Applicant's invention as described in the currently amended claims. Examiner's failure to provide the necessary suggestion or motivation for combining a test tube rack as found in Wang '650 with drawers as found in Marquette '288 creates a presumption that the combination selected by Examiner to support the obviousness rejection is based on hindsight. Thus, Examiner has not established a *prima facie* case of obviousness. Applicant respectfully requests Examiner to withdraw this rejection of Claims 1-4, 10, 12 and 14.

**CONCLUSION**

135 It is respectfully urged that the subject application is patentable over references cited by Examiner and is now in condition for allowance. The other references cited by Examiner (Wilcox '349, Gurley '660, and Spoto '665) have been read and likewise do not teach or suggest every element found in the proposed invention as claimed. Applicant requests consideration of the application and allowance of the claims as now modified. A set of claims as they are now proposed are included with this response. If there are any outstanding issues that the Examiner feels may be resolved by way of a telephone conference, the Examiner is cordially invited to contact David W. Carstens at 972.367.2001.

Date: August 24, 2005

Respectfully submitted,



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